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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,931	08/07/2001	Kim R. Smith	163.1471US01	4550

23552 7590 06/29/2005

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EXAMINER	
DELCOTTO, GREGORY R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/923,931	Applicant(s) SMITH ET AL.	
	Examiner Gregory R. Del Cotto	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Amend. filed 3/28/05*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5-11,13-15,17-38,75-78 and 85-100* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 5-11, 13-15, 17-38, 75-78, 85-100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 5-11, 13-15, 17-38, 75-78, and 85-100 are pending. Applicant's arguments and amendments filed 3/28/05 have been entered.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 12/27/04 have been withdrawn:

The objection to claim 16 under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim has been withdrawn.

The rejection of claims 1, 5-11, 13, 14, 17-19, 22-33, 35-39, 42, and 75-78 under 35 U.S.C. 103(a) as being unpatentable over Williams (US 6,159,922) has been withdrawn.

The rejection of claims 1, 5, 7-11, 13, 14, 17-20, 26-33, 35-39, 42, and 75-78 under 35 U.S.C. 102(b) as being anticipated by Trani et al (US 5,703,031) has been withdrawn.

The rejection of claims 15, 21, and 22 under 35 U.S.C. 103(a) as being unpatentable over Trani et al (US 5,703,031) has been withdrawn.

The rejection of claims 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Trani et al (US 5,703,031) as applied to claims 1, 5, 7-11, 13, 14, 17-20, 24, 25, 26-33, 35-39, 42, and 75-78 above, and further in view of Williams (US 6,159,922) has been withdrawn.

The rejection of claims 15 and 19-25 under 35 U.S.C. 103(a) as being unpatentable over Man et al (US 2003/0162685) has been withdrawn due to the filing of a statement of common ownership.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 5-11, 13-15, 17-23, 26-38, 75-78 and 85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed, provides no support for "wherein the cleaning composition is substantially free of an activator for active oxygen compound" as recited by instant claim 1 and for the subject matter of instant claim 85. The absence of a component from the examples or preferred embodiments does not provide basis for the exclusion. This is deemed new matter.

Claims 1, 5-11, 13-15, 17-23, 26-38, 75-78 and 85 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claims 1 and 85 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 5-11, 13-15, 18-22, 26-33, 36, 37, 75-78, and 85-100 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 4026806.

'806 teaches treating carpeted floors in a process with an alkaline cleaning solution which is prepared from a solid inorganic peroxide, an activator for the peroxide, a tenside, and other additives. See page 2, lines 1-10. The textile is soaked with a cleaning solution and if required, is subjected to a mechanical treatment, the solution is then removed for the most part from the carpet, for example, by vacuuming, and the textile is dried. See page 4, lines 25-35. The cleaning solution to be used on the carpets is obtained by dissolving solid inorganic peroxide, the activator for this peroxide, and the tenside in water. The pH value of the ready-to-use solution should be preferably between 9 and 12, in particular between 9.5 and 11. Further additives include sequestration agents, soil-repellent agents, inorganic salts, peroxide stabilizers, etc. See page 15, lines 1-5. Examples of suitable sequestration agents include sodium carbonate, pentasodium triphosphate, tetrasodium pyrophosphate, sodium silicate, trisodium citrate, trisodium nitrilo triacetate. Their concentration in the cleaning solution is generally not over 2.5 g. Additionally, heavy metal sequestering agents such as

EDTA and hydroxy ethane diphosphonic acid may be used in the compositions in amounts usually not over 0.1 percent by weight. See page 16, lines 1-10.

Specifically, '806 teaches solid compositions suitable for forming a cleaning solution which contain 5% oxoalcohol C14-C5 EO, 25% sodium carbonate, 10% sodium sulfate, 40% sodium perborate, 20% TAED, having a pH of 10.8. Another embodiment includes 3% oxoalcohol C14/C15 EO, 27% sodium carbonate, 60% sodium perborate, 10% TAED, having a pH of 10.5. '806 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '806 anticipate the material limitations of the instant claims.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 4026806.

'806 is relied upon as set forth above. However, '806 does not teach, with sufficient specificity, a method of cleaning carpet or upholstery, with a composition containing phosphonate, aminocarboxlate, surfactant, hydrogen peroxide, carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to clean carpets with a composition containing phosphonate, aminocarboxlate, surfactant, hydrogen peroxide, carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '806 suggests cleaning carpets with a composition

containing phosphonate, aminocarboxlate, surfactant, hydrogen peroxide, carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1, 5, 7, 11, 13, 14, 17, 18, 26-38, 75-78, and 85 are rejected under 35 U.S.C. 102(e) as being unpatentable over Man et al (US 2003/0162685). Note that, all subject matter relied upon in US 2003/0162685 finds support in the parent application 09/874841 or US 2003/0109403.

'685 teaches solid compositions for cleaning carpet in powder, solid, or agglomerate forms which include an organic sequestrant including phosphonate, aminocarboxylate, or mixtures thereof; an active oxygen compound, water, and surfactant. The solid compositions can be dissolved in an aqueous solution creating an aqueous concentrate of the active oxygen at a useful concentration. See Abstract. Note that, with respect to the process steps as recited by instant claim 1, a step such as brushing or rubbing the cleaning composition on the carpet as recited by instant claim 1 would inherently be taught by '685 and be supported in the parent application '403. '685 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the broad teachings of '685 anticipate the material limitations of the instant claims.

Response to Arguments

Note that, the fact that the examples show that activators are not essential for practice of the invention does not provide for support for clause "substantially free..." as recited by instant claim 1. With respect to '806, even though the

examples contain TAED, instant claim 1 recites "substantially free..." which would allow for the presence of some TAED. In the absence of a definition provided by Applicant in the specification, the Examiner asserts that "substantially free..." would allow for amounts of TAED as taught by '806.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5-11, 13-15, 17-38, 75-78, and 85-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-50 of copending Application No. 10/214625 and claims 1-21 and 23-25 of 10/299536. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 28-50 of 10/214625 and claims 1-21 and 23-25 of 10/299536 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to clean carpets with a composition containing

phosphonate, aminocarboxlate, surfactant, hydrogen peroxide, carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because claims 28-50 of copending Application No. 10/214625 and claims 1-21 and 23-25 of 10/299536 suggests cleaning carpets with a composition containing phosphonate, aminocarboxlate, surfactant, hydrogen peroxide, carbonate, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (703) 308-2519. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
June 27, 2005